

REMARKS

Claims 1-35 remain pending in the present application. No new matter has been added.

Claim Rejections - 35 U.S.C. §112

The present office action states that Claims 1-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 1-2, 4-10, 13, 15-16, 18-20, 22-23, 25-31 and 34 are rejected under 35 U.S.C. § 112, second paragraph, as the claims contain the trademark/trade name(s): iTunes, iPod, Macintosh and Windows. However, the applicant has not specified which versions are being claimed. “[T]he examiner asserts that there were different models of the iPod available at the time of the current Application.”

Applicants respectfully disagree with the assertions of the present Office Action. Specifically, Applicants respectfully submit that the application was filed on 2/3/2004 and as such could reasonably be expected to cover versions of the claimed matter that were either operational or available on that date such as backward compatibility. Further, the inventive aspects would clearly be expected to cover any versions that would reasonably enable one of skill using the detailed description of the instant disclosure without undo experimentation.

For these reasons, Applicants respectfully submit the rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph, based on the lack of a specific version of “iTunes”, “iPod”, “Macintosh” and “Windows” is improper and should be withdrawn as Macintosh operating system or MAC O/S had a fixed and definite meaning at the time of filing and any variations in versions would reasonably be covered in the scope of the present claimed matter is the detailed description of the instant disclosure would enable one of skill in the art, without undo experimentation, to utilize the claimed invention.

Claim Rejections - 35 U.S.C. §103

Claims 1-20 and 22-35

The present office action states that Claims 1-20 and 22-35 are rejected under 35 U.S.C. § 103(a) as being obvious over Doherty et al. (6,920,567) in view of Pastorelli et al. (2004/0133801). Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1-20 and 22-35 are not taught or rendered obvious over Doherty et al. in view of Pastorelli et al. for the following reasons.

With regard to Claim 1 (and similarly Claims 15 and 22), Applicants respectfully state that Claim 1 includes the features

“controlling a data output path carrying said media content of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism; and

directing said media content to a custom media device coupled to said compliance mechanism via said data output path, for selectively restricting output of said media content” (emphasis added).

Support for the Claimed feature can be found throughout the Figures and Specification including Figures 3 and pages 20 lines 10-17 and 21 lines 5-8.

Applicants respectfully agree with the last 2 lines of page 5 of the present Office Action that state, “Doherty et al. does not teach diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism” (emphasis added).

In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not

sufficient to render the claims *prima facie* obvious" (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Applicants agree with the statement on the top of page 6 that understands Pastorelli et al. to teach intercepting an execution request.

According to Marriam-Webster's to define intercept as: a transitive verb

1. obsolete : prevent , hinder
2. a: to stop, seize, or interrupt in progress or course or before arrival
b: to receive (a communication or signal directed elsewhere) usually secretly
3. obsolete : to interrupt communication or connection with

In Contrast, Marriam-Webster defines divert as: intransitive verb

1. to turn aside : deviate <studied law but diverted to diplomacy>
transitive verb

1 a: to turn from one course or use to another : deflect <divert traffic to a side street>
b: distract <trying to divert her attention

Thus, Applicants respectfully submit that the feature "controlling a data output path of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism" (emphasis added); is not taught or render obvious over Doherty et al. or Pastorelli et al. and, in fact, would change the method of operation of both Doherty et al. and Pastorelli et al.

Instead, Applicants respectfully submit that Doherty et al. and Pastorelli et al. presently addresses the same problem as the present invention and provide distinctly different solutions to the same problem. That is, as the instant Office Action states, on page 6 lines 1-3, "Pastorelli et al teaches intercepting an execution request. Compliance of the execution request with authorized conditions is verified. Starting of the product is enabled or prevented according to the result of the verification [0045]" (emphasis added).

As such, Applicants respectfully submit that the modification of Doherty et al. in view of Pastorelli et al. as suggested by the present Office Action would not result in the teaching or rendering obvious of the Claimed features, “controlling a data output path carrying said media content of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism; and

directing said media content to a custom media device coupled to said compliance mechanism via said data output path, for selectively restricting output of said media content” (emphasis added).

In other words, Applicants respectfully submit, that the combination of the teachings of Doherty et al. and Pastorelli et al. would not have prompted a person of ordinary skill in the relevant field to combine the elements in the way the instant claims require.

Thus, Applicants respectfully submit the present rejection rests on speculation and less than a preponderance of the evidence and thus, fails to provide sufficient reasons for finding claims 1-20 and 22-35 unpatentable for obviousness under 35 U.S.C. 103(a) over Doherty et al. in view of Pastorelli et al.

For this reason, Applicants respectfully submit that Doherty et al. in view of Pastorelli et al. does not teach or render obvious the features Claimed in Claims 1, 15 and 22. As such, Applicants respectfully submit that Claims 1, 15 and 22 are not taught or rendered obvious by Doherty et al. in view of Pastorelli et al.

Additionally, on page 6 at approximately lines 10-12, the instant Office Action provides a motivation for the combination. Specifically, the Office Action states, “It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al by the teachings of Pastorelli et al because it allows programs running on the device to be controlled in real time. In this

way, a very effective licensing validation is carried out at low cost [0046]" (emphasis added).

Applicants respectfully agree with the assertions of the combination of Doherty et al by the teachings of Pastorelli et al. However, Applicants again point out that the assertions of the Instant Office Action do not result in the teaching or rendering obvious of the Claimed features, "controlling a data output path carrying said media content of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism; and

directing said media content to a custom media device coupled to said compliance mechanism via said data output path, for selectively restricting output of said media content" (emphasis added).

In other words, in the present claimed features, the media content presentation application is not controlled. Instead, the claimed feature, clearly provide, "controlling a data output path carrying said media content of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism" (emphasis added).

For this additional reason, Applicants respectfully submit that Doherty et al. in view of Pastorelli et al. does not teach or render obvious the features Claimed in Claims 1, 15 and 22. As such, Applicants respectfully submit that Claims 1, 15 and 22 are not taught or rendered obvious by Doherty et al. in view of Pastorelli et al.

With respect to Claims 2-14, Applicants respectfully state that Claims 2-14 depend from the allowable Independent Claim 1 and recite further features of the present claimed invention. With respect to Claims 16-20, Applicants respectfully point out that Claims 16-20 depend from the allowable Independent Claim 15 and recite further features of the present claimed invention. With respect to Claims 23-35, Applicants

respectfully point out that Claims 23-35 depend from the allowable Independent Claim 22 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-14, 16-20 and 23-35 are at least allowable as pending from allowable base Claims.

Claim 21

In the Office Action, Claim 21 is rejected under 35 USC 103(a) as being unpatentable over Doherty et al. and Pastorelli et al. in view of Rhoads et al. (6,422,285). Applicants have reviewed the cited reference and respectfully submit that the present invention is not rendered obvious over Doherty et al. in view of Rhoads et al. for the following rationale.

Applicants respectfully submit that Claim 15 includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and

preventing decryption of said media content on said client system having said Macintosh operating system operating thereon if a portion of said compliance mechanism is invalidated.” (emphasis added).

For the reasons previously provided herein, Applicants respectfully submit that Claim 15 is not render obvious by Doherty et al. in view of Pastorelli et al. Moreover, the combination Doherty et al. and Pastorelli et al. in view of Rhoads et al. does not overcome the shortcomings of Doherty et al. in view of Pastorelli et al. As such, Applicants respectfully submit that Claim 15 is presently allowable.

With respect to Claim 21, Applicants respectfully submit that Claim 21 depends from the allowable Claim 15 and recites further features of the present claimed invention. Therefore, Applicants respectfully state that Claim 21 is at least allowable as pending from an allowable base Claim.

CONCLUSION

Based on the amendments herein and arguments presented above, Applicants respectfully assert that Claims 1-35 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
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